

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SNEHAL M. SHAH

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Appeal No. 1996-2731  
Application 08/240,862

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ON BRIEF

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Before WILLIAM F. SMITH, SPIEGEL, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 3-6, 8, 9, 12, 13, 17, 18 and 21-23, all the claims pending in the application. Claim 21 is representative of the subject matter on appeal and reads as follows:

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21. A water-based hair preparation containing as its essential cosmetically active ingredients from about 78.1 to about 60.6 weight percent of hydrolyzed wheat protein and wheat oligosaccharide, from about 6.3 to about 12.1 weight percent of wheat amino acids, from 15.6 to about 24.3 weight percent panthenol; and from about 0 to about 3 weight percent of panthenyl ethyl ether.

The references relied upon by the examiner are:

Maes et al. (Maes)	4,705,681	Nov. 10, 1987
Syed et al. (Syed)	5,348,737	Sep. 20, 1994 (filed July 21, 1993)

BROOKS INDUSTRIES inc. (Brooks), Cosmetic Ingredients & Ideas®, "PLANT PROTEINS, Versatile Alternative Cosmetic Grade Proteins", (Spring 1992).

#### GROUND OF REJECTION ON APPEAL

Initially, we note that the issue of whether the examiner properly required appellant to cancel "new matter" from the specification relates to a petitionable matter and not to an appealable matter. See, In re Hengehold, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971), see also, MPEP § 1002.02(c), item 3(b). Accordingly, we will not review this issue raised by appellant on pages 5-7 of the brief. We further note the examiner's statement at page 4 of the Examiner's Answer (Paper No. 12, mailed September 25, 1995), "[c]laim 13 is allowable of the prior art of record. Claims 17 and 18 are objected to as being dependent upon a rejected base claim." Therefore, we will not address claims 13, 17 and 18. In addition, we note that the examiner withdrew the final rejection of claims 1-18 under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the

components and concentrations listed on page 9 and Table I of the specification. The examiner also withdrew the final rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention with respect to the phrases “[a]ctive ingredients” and “consisting essentially of”. See, Examiner’s Answer (Paper No. 12, mailed September 25, 1995), page 3. The remaining issue on appeal is the rejection of claims 3, 5, 6, 8, 9, 12 and 21-23 under 35 U.S.C. § 103 as being unpatentable over Maes, Brooks and Syed. We reverse.

### DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. We make reference to the Examiner’s Answer for the examiner’s reasoning in support of the rejection. We further reference appellant’s Brief (Paper No. 11, filed September 11, 1995) for the appellant’s arguments in favor of patentability.

Maes teaches a water-based hair treating composition comprising 9 parts by weight d-panthenyl ethyl ether per 1 part by weight d-panthenol. See, e.g., Maes, Column 2, Table 1, and claim 1. The examiner recognizes on page 3A<sup>1</sup> of the Examiner's Answer, that "Maes fails to teach the inclusion of the claimed wheat components." To make up for the deficiency in Maes, the examiner provides Brooks and Syed for their teaching of hydrolyzed wheat protein for hair treatments. The examiner concludes in the bridging paragraph of pages 3A-4 of the Examiner's Answer that "[i]t is prima facie obvious to combine two composition [sic] each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose."

Appellant argues that the Maes formulation must contain both d-panthenyl ethyl ether and d-panthenol in a very specific weight ratio of 9:1 panthenyl ethyl ether to panthenol. Appellant argues that in contrast to Maes' formulation, appellant's invention does not require the presence of panthenyl ethyl ether and that when panthenyl ethyl ether is present it is at a lower concentration than panthenol. See, Brief, bridging paragraph, pages 13-14. In addition, appellant argues, at page 14 of the Brief, that Maes teach away from appellant's claimed invention by disclosing the advantages of a 1:9 pantenol:pantenyl ethyl

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<sup>1</sup> We note that the Examiner's Answer contains two pages numbered page "3". For clarity, we refer the first occurrence of page "3" as page 3, and the second occurrence of page "3" as page 3A.

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ether formulation over a commercially available 7:3 pantenol:pantenyl ethyl ether formulation.

The initial burden of establishing reasons for unpatentability rests on the examiner. See, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Here, the examiner has failed to state how a person having ordinary skill in the art would have found appellant's claimed invention obvious. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has not explained how a person having ordinary skill in the art would have arrived at the composition recited in the claims on appeal in view of the primary reference teaching away from the claimed invention. "[W]hile it may ordinarily be the case that the determination of optimum values for the parameters of a prior art process would be at least prima facie obvious, that conclusion depends upon what the prior art discloses with respect to those parameters." In re Sebek, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972). Accordingly, the examiner has failed to establish a *prima facie* case of obviousness.

Having determined that the examiner has not established a *prima facie* case of obviousness, we find it unnecessary to discuss appellant's unexpected results relied upon to rebut any such *prima facie* case.

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REVERSED

WILLIAM F. SMITH	)	
Administrative Patent Judge	)	
	)	
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	)	
CAROL A. SPIEGEL	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
DONALD E. ADAMS	)	
Administrative Patent Judge	)	

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